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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/361,630	07/27/99	ZUKER	C 2307E-084210

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EXAMINER

WINKLER, U

ART UNIT	PAPER NUMBER
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1645

DATE MAILED:

8
06/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/361,630

Applicant(s)

ZUKER ET AL.

Examiner

Ulrike Winkler, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-93 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-9, 15, 16, 32-40, 46, 47, 63-71, 77 and 78 drawn to nucleic acids and an expression vector, classified in class 530, subclass 23.1.
- II. Claim 10-13, 41 -44 and 72-75, drawn to a polypeptide, classified in class 530, subclass 350.
- III. Claims 14, 45, 76, drawn to antibodies, classified in class 530, subclass 389.1.
- IV. Claims 17-28, 48-59 and 79-90, drawn to a method of identifying compounds that modulate the sensory signal, classified in class 435, subclass 7.1.
- V. Claims 29, 60 and 91, drawn to a method of making a polypeptide, classified in class 435, subclass 69.1.
- VI. Claims 30, 61 and 92, drawn to a method of making a recombinant cell, classified in class 435, subclass 325.
- VII. Claims 31, 62 and 93, drawn to a method of making an expression vector, classified in class 435, subclass 320.1.

The inventions are distinct, each from the other because of the following reasons:

Groups I-III are compositions and are distinct from groups IV-VII which are drawn to methods. Groups I-III are compositions and each is distinct from the other because they contain different materials. Group I comprises nucleic acids. Group II comprises a polypeptide which is made up of amino acids. Group III comprises an antibody, although antibodies themselves are proteins, they are different molecules with different structures. Though there may be overlap for groups, the search for one group will not be coextensive with that of the other group.

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Groups IV-VII are drawn to methods and each is distinct from the other because they utilize different starting materials, therefore the outcomes are not be expected to be the same. Groups VI is drawn to a method of identifying compounds that modulate sensory activities Group V is drawn to a method of making proteins. Group VI is a method of making a recombinant cell. Group VII is a method of making an expression vector. The methods utilize different techniques and starting materials, therefore the outcome would not be expected to be the same.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper. Furthermore, because these inventions are distinct for the reasons given above and the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

Additionally, Group I-VII contains claims directed to the following patentably distinct species of the claimed invention:

- A) Taste Cell Polypeptide 1 (SEQ ID: 1, 2, 10, 11, 19 and 20)
- B) Taste Cell Polypeptide 2 (SEQ ID: 3, 4, 12, 13, 21 and 22)
- C) Taste Cell Polypeptide 3 (SEQ ID: 5, 6, 14, 15, 23 and 24)

These species are distinct because their structures and modes of action are different which, in turn address different purification, diagnostic or therapeutic endpoints. The sequences differ with respect to their structure, a person of ordinary skill in the art would not envision one in view of the other.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294. The examiner can normally be reached M-F, 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached at 703-308-3995.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for informal communications use 703-308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Ulrike Winkler, Ph.D.


JEFFREY STUCKER
PRIMARY EXAMINER